

REMARKS

Claims 1-8 were pending in the application. Upon entry of the following remarks, claims 1-8 will be pending and under active consideration. Claims 1 is independent.

Applicant wishes to take this opportunity to thank Examiner for Examiner's acknowledgement that the subject matter of claims 2-4 and 6-8 would be allowable if rewritten to include all the limitations of the base claims from which they depend as well as any intervening claim(s).

Applicant respectfully requests entry of the remarks made herein into the file history of the present invention. Reconsideration and withdrawal of the rejections set forth in the above-identified Office Action are respectfully requested.

I. The Rejections Under 35 U.S.C. § 102(b) Should Be Withdrawn

The Office Action, at page 2, rejects claims 1 and 5 as allegedly being anticipated by U.S. Patent No. 5,348,220 to Setteducati (hereinafter, "Setteducati"), under 35 U.S.C. § 102(b). The Office Action alleges that Setteducati discloses an apparatus comprising a case main body which is formed into a parallelepiped; a coin receiving opening closing lid for closing a coin receiving opening which is one of openings of the case main body; an interior of the case main body is divided by a partition plate into two portions; the partition plate is fixed to an interior surface of a top wall of the case main body and a slit is formed between a lower end of the partition plate and a bottom wall of the case main body. The Office Action further alleges that Setteducati discloses that the accommodating opening closing lid is constructed so as to be brought into engagement with the case main body at the coin accommodating opening so that the

closing lid does not come off the coin accommodating opening while being operated. Applicant traverses respectfully.

Applicant submits respectfully that claims 1 and 5 are not anticipated by Setteducati because Setteducati does not disclose each and every element of those amended claims as is required for a *prima facie* showing of anticipation under 35 U.S.C. § 102(b). Setteducati discloses a savings box that presents an illusion that a coin *disappears* when loaded into the box via a slide. The present invention presents a box for creating an illusion that a coin *multiplies* when loaded into the box via a slide. Thus, the inventions are different and distinct. In particular, present claim recites “a coin accommodating portion . . . for accommodating coins in a state in which coins are stacked one on another vertically in advance.” This element is not disclosed in Setteducati.

For a proper anticipation rejection under 35 U.S.C. § 102(b), no difference may exist between the claimed invention and the reference disclosure. See *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q. 841 (C.A.F.C. 1984). Anticipation by a reference requires the disclosure within that reference of each and every element as set forth in the Applicant's claims. See *Hodosh v. Block Drug Co.*, 229 U.S.P.Q. 182 (Fed. Cir. 1986); *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986); and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986).

Accordingly, as Setteducati does not disclose all of the elements of the present invention as recited in claims 1 and 5, Applicant submits respectfully that those claims are not properly rejected under 35 U.S.C. § 102(b). Therefore, Applicant requests respectfully that the rejection to claims 1 and 5 under 35 U.S.C. § 102(b) be withdrawn.

AUTHORIZATION

Applicant believes there is no fee due in connection with this filing. However, to the extent required, the Commissioner is hereby authorized to charge any fees due in connection with this filing to Deposit Account 19-5127 (Order No. 18920.0047) or credit any overpayment to same.

CONCLUSION

Applicant submits respectfully that the present application is in condition for allowance. Favorable reconsideration, withdrawal of the rejections set forth in the above-noted Office Action, and an early Notice of Allowance are requested.

If the Examiner feels that an interview would facilitate the prosecution of this application, Applicants respectfully urge the Examiner to contact the undersigned directly at 202-295-8466.

In general, Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 424-7500. All correspondence should be directed to our address given below.

Respectfully submitted,



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